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09/514,649	02/29/2000	Kiyoshi Toyoda	P19157	2077
7055	7590	02/07/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C. 1950 ROLAND CLARKE PLACE RESTON, VA 20191			PARK, CHAN S	
			ART UNIT	PAPER NUMBER
			2622	
DATE MAILED: 02/07/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/514,649

**Applicant(s)**

TOYODA, KIYOSHI

**Examiner**

CHAN S PARK

**Art Unit**

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 17-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19,23 and 27 is/are allowed.
- 6) ☒ Claim(s) 17,18,20-22,24-26 and 28-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/23/04 has been entered.

### ***Response to Amendment***

2. Applicant's amendment was received on 11/23/04, and has been entered and made of record. Currently, **claims 17-35** are pending.

### ***Response to Arguments***

3. Applicant's arguments with respect to **claims 17, 18, 20-22, 24-26 and 28-35** have been considered but are moot in view of the new ground(s) of rejection.

### ***Specification***

4. The abstract of the disclosure is objected to because "PC" is misspelled in line 5. Correction is required. See MPEP § 608.01(b).

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 17, 18, 21, 24-26, 28-31 and 33-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoshida et al. U.S. Patent No. 6,801,546 (hereinafter Yoshida).

5. With respect to claim 17, Yoshida discloses an image communication apparatus (electronic mail fax machine 1-2 in fig. 8) comprising:

a receiver configured to receive image data from a transmitting facsimile (facsimile machine 1-17) apparatus via a public switched phone network (fig. 1);

a printer configured to print the received image data (col. 12, lines 35-36); and  
a controller configured to:

convert the received image data to data for internet transmission (col. 5, lines 31-34; col. 8, lines 39-42; and S9-10);

attach the converted data to an e-mail (col. 5, lines 31-34; col. 8, lines 39-42; and S9-10); and

transmit the e-mail to a management center (electronic mail fax machine 1-11 in col. 14, lines 25-27), the management center configured to manage information (relay fax information, including address information, mode information and the image

data, generated/requested by the originating facsimile machine 1-17) that the image communication apparatus receives (col. 14, lines 11-17 and lines 41-46) and further configured to connect to the image communication apparatus via the Internet (1-6 in fig. 1), the transmitted e-mail corresponding to the printed image data as the received image data printed by the printer (col. 2, lines 10-19).

6. With respect to claim 18, Yoshida discloses the image communication apparatus according to claim 17, wherein the management center is configured to store information that the image communication apparatus receives, the information being browsed by a supervisor of the management center (col. 14, lines 11-17 and lines 41-46). Additionally, it is noted that the electronic mail fax machine 1-11 inherently stores the relay facsimile information, including address information, mode information and the image data, for the further processes (13-4 ~ 13-7 in fig. 13).

7. With respect to claim 21, Yoshida discloses the image communication apparatus according claim 20, wherein the management center stores information that the image communication apparatus transmits to the destination, the information being browsed by a supervisor of the management center (col. 14, lines 11-17 and lines 41-46).

Additionally, it is noted that the electronic mail fax machine 1-11 inherently stores the relay facsimile information, including address information, mode information and the image data, either permanently or temporarily for the further processes (13-4 ~ 13-7 in fig. 13).

8. With respect to claim 24, Yoshida discloses an image communication apparatus comprising:

a facsimile transmitter (electronic mail fax machine 1-2 in fig. 8) configured to transmit image data to a destination based on a facsimile protocol (fig. 1); and

an e-mail transmitter configured to:

convert the image data to data for Internet transmission;

attach the converted data to an e-mail (col. 5, lines 31-34; col. 8, lines 39-42; and S9-10); and

transmit the e-mail to a management center (electronic mail fax machine 1-11 in col. 14, lines 25-27), the management center configured to manage image data that is transmitted by the facsimile transmitter (relay fax information, including address information, mode information and the image data, generated/requested by the originating facsimile machine 1-17), and further configured to connect to the image communication apparatus via the Internet (1-6 in fig. 1), the transmitted e-mail corresponding to the image data transmitted by the facsimile transmitter (col. 2, lines 10-19).

9. With respect to claim 25, arguments analogous to those presented for claim 18, are applicable.

10. With respect to claim 26, Yoshida discloses the image communication apparatus according claim 24, wherein the e-mail transmitter sets an e-mail address of the management center in a "To" field of the e-mail (col. 14, lines 12-14).

11. With respect to claim 28, arguments analogous to those presented for claim 17, are applicable.

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12. With respect to claim 29, arguments analogous to those presented for claim 18, are applicable.

13. With respect to claim 30, Yoshida teaches an image communication method comprising:

scanning image data (col. 9, lines 39-40);

inputting an address of a destination (col. 9, lines 42-46);

converting the received image data to data for Internet transmission;

attaching the converted data to an e-mail (col. 5, lines 31-34; col. 8, lines 39-42;

and S9-10); and

transmitting the e-mail to the input destination via the Internet and to a management center via the Internet, the management center managing information transmitted to the destination, the management center being distinct from the-input destination (col. 2, lines 10-19 & col. 14, lines 25-27).

14. With respect to claim 31, arguments analogous to those presented for claim 18, are applicable.

15. With respect to claim 33, arguments analogous to those presented for claim 24, are applicable.

16. With respect to claim 34, arguments analogous to those presented for claim 25, are applicable.

17. With respect to claim 35, arguments analogous to those presented for claim 26, are applicable.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida.

18. With respect to claim 20, as set forth above, Yoshida discloses the image communication apparatus according to claim 17. Note that, at the time of the invention, it would have been obvious to one of ordinary skill in the art to use the electronic mail facsimile machine (1-2 or 1-11) as the originating facsimile machine (1-17). Also, it would have been obvious to one of ordinary skill in the art to send the scanned image data for the relay facsimile transmission straight from electronic mail facsimile (1-2). The suggestion/motivation for doing so would have been to send facsimile data along with the relay fax information from an electronic mail apparatus since the electronic mail apparatus supports both normal facsimile protocol and the Internet facsimile protocol for the relay facsimile transmission. Now, by implementing such a modification, the reference of Yoshida discloses an image communication apparatus comprising:

a scanner configured to scan image data (col. 12, lines 38-39);

a panel configured to input an address of a destination (col. 12, lines 41-42); and

a controller configured to:

convert the received image data to data for Internet transmission;

attach the converted data to an e-mail (col. 5, lines 31-34; col. 8, lines 39-42; and S9-10); and

transmit the e-mail to the destination (facsimile machine 1-13) input by the panel and to a management center (electronic mail fax machine 1-11 in col. 14, lines 25-27), the management center configured to manage information (relay fax information, including address information, mode information and the image data, generated/requested by the originating facsimile machine 1-17) that the image communication apparatus transmits to the destination (col. 14, lines 11-17 and lines 41-46), and further configured to connect to the image communication apparatus via the Internet (1-6 in fig. 1), the management center being distinct from the destination input by the panel (col. 2, lines 10-19).

Therefore, it would have been obvious to one of ordinary skill in the art to obtain the invention as specified in claim 20.

19. With respect to claim 21, arguments analogous to those presented for claim 17, are applicable.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claim 20 above, and further in view of Wolf U.S. Patent No. 6,535,303.

20. With respect to claim 22, as set forth above, Yoshida discloses the image communication apparatus according to claim 20, wherein the controller sets a mail address of a transmission destination in a "To" field of the e-mail along with a mail address of the management center using delimiter (fig. 7 and col. 11, lines 9-16).

Yoshida, however, does not disclose expressly that the mail address of the management center is set in a "Bcc" field of the e-mail.

Wolf, the same field of endeavor of the facsimile transmission and broadcast art, discloses a facsimile controller for setting destination addresses in both "cc" and "Bcc" fields of the e-mail for facsimile transmission.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the means for setting the destination addresses in both "cc" and "Bcc" fields of the e-mail of Wolf with the relay facsimile apparatus of Yoshida.

The suggestion/motivation for doing so would have been to distinguish the addresses of the final destination and the relay station using the "cc" and "Bcc" fields of the e-mail.

Therefore, it would have been obvious to combine Yoshida with Wolf to obtain the invention as specified in claim 22.

Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshida as applied to claim 30 above, and further in view of Wolf.

21. With respect to claim 32, arguments analogous to those presented for claim 22, are applicable.

***Allowable Subject Matter***

22. **Claims 19, 23 and 27** are allowed.

**Conclusion**


23. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S PARK whose telephone number is (703) 305-2448. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (703) 305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park  
Examiner  
Art Unit 2622

csp  
February 3, 2005

  
EDWARD COLES  
SUPERVISORY PATENT EXAMINER  
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